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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,827	05/25/2001	Douglas Simpson	ClaimsPlace	7658

45722 7590 04/04/2007	EXAMINER
PLEVY & HOWARD & DARCY P.C. P.O. BOX 226 Fort Washington, PA 19034	KOPPIKAR, VIVEK D

	ART UNIT	PAPER NUMBER
	3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/865,827	SIMPSON ET AL.
	Examiner	Art Unit	
	Vivek D. Koppikar	3626	.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 January 2007</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>3,5-10,14-25,27,29-32 and 35-44</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>3, 5-10, 14-25, 27, 29-32 and 35-44</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of the Application

1.   Claims 3, 5-10, 14-25, 27, 29-32 and 35-44 have been examined in this

application. This communication is the first action on the merits since the applicants

filed a Request for Continued Examination (RCE) on January 3, 2007.

Claim Objections

2.   Claims 3, 5-10, 145-25, 27, 29-32 and 35-44 are objected to because of the

following informalities: It appears that a central feature of the applicants invention is that

it allows users to self-service insurance claims. However, this feature of self-servicing

insurance claims is mentioned only in the preamble. The Examiner recommends actively

claiming this feature in the bodies of the independent claims.

Claim Rejections - 35 USC § 103

3. .   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 3, 5-10 and 14-15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Borghesi in view of "Cutting Out the Middleman" (hereinafter referred

to as Middleman) and in further view of US Patent Number 2002/0019754 to Peterson

and in further view of "Automating collision claims" (hereinafter referred to as.

Automating).

(A)   As per claims 3, Borghesi teaches a computer system for enabling claimants to

self-service insurance claims for sustained, the system comprising:

a site generating component for generating a site on a global computer network
for inputting insurance claims from a plurality of sources (Borghesi: Col. 5, Ln. 51-Col.
6, Ln. 14);

a claim data analyzing component for analyzing the inputted insurance claim
using deep domain knowledge about claim processing (Borghesi: Col. 13, Ln. 12-41);

Borghesi does not teach the following features which are taught by Peterson: 1)
enabling claimants to self-service insurance claims (Peterson: Section [0022]); 2)
allowing claimants to directly input the insurance claims (Peterson: Section [0022]) and
3) a claim rehabilitation component (Peterson: Section [0050]).

At the time of the invention, it would have been obvious for one of ordinary skill
in the art to have modified the teachings of Borghesi with the aforementioned teachings
from Peterson with the motivation of having an automated means for processing claims,
as recited in Peterson (Section [0003]).

Middleman teaches a system which allows insureds access to services so that they
can self-service various insurance transactions. At the time of the invention, it would
have been obvious for one of ordinary skill in the art to have modified the teachings of
Middleman so that that the system of Middleman would have been able to allow claims
to self-service their own insurance claims with the motivation of having a means to
reduce paperwork as well as administrative and sales costs, as recited in Middleman
(Page 2, Paragraph 4).

The above references do not teach the following feature which is taught by
Automating (Page 2, Paragraphs 1-2): a claim rehabilitation component aggregating

services related to loss recovery and automatically providing the aggregated services to the claimants to rehabilitate the sustained losses in accordance with said analyzing. At the time of the invention, it would have been obvious for one of ordinary skill in the insurance industry to have modified Borghesi with the aforementioned teachings from Automated with the motivation of having a means of being able to save money when insurance claims are processed, as recited in Automated (Page 2, Paragraph 2).

(B)   As per claim 5, in Borghesi the site is operative as an online claim reporting hub that permits the claimants to report details of personal and commercial insurance claims against any of a plurality of insurers (Borghesi: Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(D)   As per claim 6, in Borghesi the claimants include individuals and institutions (Borghesi: Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(E)   As per claim 7, in Borghesi the input insurance claims are selected from the group consisting of automobile claims, homeowners claims and business claims (Borghesi: Col. 2, Ln. 32-37).

(F)   As per claim 8, in Borghesi the site generating component accepts inputs from the global computer network and respond to site users graphically, in sound and in printable forms (Borghesi: Col. 12, Ln. 59-61).

(G)   As per claim 9, in Borghesi the system provides substantially continuous network claim service handling (Borghesi: Col. 5, Ln. 51-Col. 6, Ln. 5).

(H)   As per claim 10, in Borghesi the computer system further comprising a privacy preserving component for preserving site users' privacy while online at the site (Borghesi: Col. 15, Ln. 24-33).

(I)   As per claim 14, in Borghesi the computer system according to claim 3, wherein

the system is adapted to process claims processing without an agent, broker or an

insurance company (Borghesi: Figure 3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(J)   As per claim 15, in Borghesi the site is operative as an online consumer-to-

business exchange that permits vendors of goods and services to advertise and offer

products that individuals and businesses require to rehabilitate a loss (Borghesi: Col. 5,

Ln. 5-50).

(K)   As per claim 25, this claim is substantially similar to claim 3 insofar as claim

limitations are concerned and is therefore rejected in the same manner as claim 3. (The

only difference between claim 3 and claim 25 is that claim 3 is directed towards a system

while claim 25 is directed towards a method).

(P)   As per claim 27, wherein the site is operative as an online claim reporting hub that

permits insurance claims to be put against any of a plurality of insurers at substantially

any time (Borghesi: Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(R)   As per claim 29, in Borghesi the insurance claims are selected from the group

consisting of automobile claims, homeowners claims and business claims (Borghesi: Col.

2, Ln. 32-37).

(S)   As per claim 30, in Borghesi the site generating step includes accepting inputs

from the global computer network and responding to site users graphically, in sound and

in printable forms (Borghesi: Col. 12, Ln. 59-61).

(T)   As per claim 31, in Borghesi the site generating step includes providing

substantially continuous network claim service handling (Borghesi: Col. 5, Ln. 51-Col. 6,

Ln. 5).

(U)   As per claim 32, Borghesi teaches further the step of preserving site users'

privacy while online at the site (Borghesi: Col. 15, Ln. 24-33).

(X)   As per claim 35, in Borghesi the site is operative as an online consumer-to-

business exchange that permits vendors of goods and services to advertise and offer

products that individuals and businesses require to rehabilitate a loss (Borghesi: Col. 5,

Ln. 5-50).

(Y)   As per claim 36, in Borghesi the aggregating step includes suggesting multiple

vendors and services for performing tasks and requirements associated with rehabilitating

a claim (Borghesi: Col. 5, Ln. 5-50).

5.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi

in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman) and in

further view of Peterson and in further view of "Automating collision claims"

(hereinafter referred to as Automating) as applied to Claim 3 above and in further view of

Progressive.com (March 1, 2000).

(A)   As per claim 16, Borghesi does not teach multiple vendors and services for

performing tasks and requirements associated with rehabilitating a claim, however, this

feature is well known in the art as evidenced by Progressive.com (Page 1). At the time of

the invention, it would have been obvious for one of ordinary skill in the art to have

modified the system of Borghesi and add the aforementioned feature from

Progressive.com with the motivation of providing a user with a means of comparing

insurance policies before making a purchase, as recited in Progressive.com (Page 1).

6.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman) and in further view of Peterson and in further view of "Automating collision claims" (hereinafter referred to as Automating) as applied to Claim 3 above and in further view of US Patent Number 5,704,045 to King.

(A)   As per claim 17, Borghesi does not teach that the site is operative as an online business-to-business exchange where sellers, market makers and investors transact for wholesale claims, post-accident purchase and sale of tranches of risk obligations, and subrogation rights, however, this feature is well-known in the art as evidenced by King (Col. 14, Ln. 42-58). At the time of the invention, one of ordinary skill it would have been obvious for one of ordinary skill in the art to have modified the system of Borghesi with the aforementioned feature from King with the motivation of providing a means for investors to provide funds to support risk, as recited in King (Col. 14, Ln. 42-45).

7.   Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman) and in further view of Peterson and in further view of "Automating collision claims" (hereinafter referred to as Automating) in view of King as applied to Claim 17 above and in further view of US Patent Number 5,655,085 to Ryan.

(A)   As per claims 18-19, Borghesi in view of King does not teach an automatic claim scoring and valuing component for automatically scoring a claim to determine the likelihood of recovery and valuing a claim. Borghesi in view of King also does not teach the feature whereby the automatic claim scoring and valuing component values a claim's subrogation value by reviewing criteria including accident description, loss state, and

responsible party and then assigns a subrogation value to the claim; however, the aforementioned features are well known in the art as evidenced by Ryan (Col. 1, Ln. 38-51). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Borghesi in view of King with the aforementioned teachings from Ryan with the motivation of providing a means for the subrogation rights purchasers to automatically determine which product provides the best value, as recited in Ryan (Col. 1, Ln. 45-49).

8.   Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman) and in further view of Peterson and in further view of "Automating collision claims" (hereinafter referred to as Automating) in view of King and Ryan as applied to Claim 19 above and in further view of US Patent Number 5,307,262 to Ertel.

(A)   As per claims 20-21, the combined system of Borghesi in view of King and Ryan do not teach a claim bundling component that bundles the scored and claimed values into a group of claims that have commonality to the claim. The combined system of Borghesi in view of King and Ryan also does not teach a sale price determining component for determining a sale price for the bundled group of claims, however, the aforementioned features are well known in the art as evidenced by Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Borghesi in view of King and Ryan with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

9.   Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Borghesi in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman)

and in further view of Peterson and in further view of "Automating collision claims"

(hereinafter referred to as Automating) as applied to Claim 3 above and in further view of

US Patent Number 6,453,297 to Burks.

(A)   Borghesi does not teach a database which permits selected users to search for

similar Claims (identify data patterns), thereby enabling the selected users to identify

potential claims which are likely to develop as class action suits or mass tort claims.

Borghesi also does not teach an identity concealment component (generic data format)

for concealing the identities of claimants of the claims when searching for similar claims

in the database, however, the aforementioned features are well known in the art as

evidenced by Burks (Col. 16, Ln. 34-46). At the time of the invention, it would have

been obvious for one of ordinary skill in the art to have modified the system of Borghesi

with the aforementioned feature from Burks with the motivation of providing a user with

a means of containing insurance costs, as recited in Burks (Col. 16, Ln. 42-45).

10.   Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the

combined system of Borghesi in view of "Cutting Out the Middleman" (hereinafter

referred to as Middleman) and in further view of Peterson and in further view of

"Automating collision claims" (hereinafter referred to as Automating) in view of Burks

and in further view of Ertel.

(A)   The combined system of Borghesi in view of Burks also does not teach a sale

price determining component for determining a sale price for the bundled group of

claims, however, the aforementioned features are well known in the art as evidenced by

Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would

have been obvious for one of ordinary skill in the art to have modified the combined

system of Borghesi in view of King and Ryan with the aforementioned feature from Ertel

with the motivation of facilitating the generation of a wide variety of useful summary

reports, as recited in Ertel (Col. 29, Ln. 25-28).

11.   Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi

in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman) and in

further view of Peterson and in further view of "Automating collision claims"

(hereinafter referred to as Automating).as applied to Claim 25 above and in further view

of US Patent Number 5,704,045 to King.

(A)   As per claim 37, Borghesi does not teach that the site is operative as an online

business-to-business exchange where sellers, market makers and investors transact for

wholesale claims, post-accident purchase and sale of tranches of risk obligations, and

subrogation rights, however, this feature is well-known in the art as evidenced by King

(Col. 14, Ln. 42-58). At the time of the invention, one of ordinary skill it would have

been obvious for one of ordinary skill in the art to have modified the method of Borghesi

with the aforementioned feature from King with the motivation of providing a means for

investors to provide funds to support risk, as recited in King (Col. 14, Ln. 42-45).

12.   Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Borghesi in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman)

and in further view of Peterson and in further view of "Automating collision claims"

(hereinafter referred to as Automating) in view of King as applied to Claim 37 above and

in further view of US Patent Number 5,655,085 to Ryan.

(A)   As per claims 38-39, Borghesi in view of King does not teach an automatic claim

scoring and valuing component for automatically scoring a claim to determine the

likelihood of recovery and valuing a claim. Borghesi in view of King also does not teach

the feature whereby the automatic claim scoring and valuing component values a claim's

subrogation value by reviewing criteria including accident description, loss state, and

responsible party and then assigns a subrogation value to the claim; however, the

aforementioned features are well known in the art as evidenced by Ryan (Col. 1, Ln. 38-

51). At the time of the invention, it would have been obvious for one of ordinary skill in

the art to have modified the combined method of Borghesi in view of King with the

aforementioned teachings from Ryan with the motivation of providing a means for the

subrogation rights purchasers to automatically determine which product provides

the best value, as recited in Ryan (Col. 1, Ln. 45-49).

13.   Claims 40-44 are rejected are rejected under 35 U.S.C. 103(a) as being

unpatentable over Borghesi in view of "Cutting Out the Middleman" (hereinafter referred

to as Middleman) and in further view of Peterson and in further view of "Automating

collision claims" (hereinafter referred to as Automating) in view of King and Ryan as

applied to Claim 39 above and in further view of US Patent Number 5,307,262 to Ertel.

(A)   As per claims 40-44, the combined system of Borghesi in view of King and Ryan

do not teach a claim bundling component that bundles the scored and claimed values into

a group of claims that have commonality to the claim. The combined method of

Borghesi in view of King and Ryan does not teach a sale price determining component

for determining a sale price for the bundled group of claims. The combined method of

Borghesi in view of King and Ryan does not teach a step of providing a database and permitting selected users to search for similar claims, thereby enabling the selected users to identify potential claims which are likely to develop as class action suits or mass tort claims. The combined method of Borghesi in view of King and Ryan also does not teach the step of concealing the identities of the claimants of the claims during the claim searching step nor the step of pooling common issues into anonymous class action groups, however, the aforementioned features are well known in the art as evidenced by Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Borghesi in view of King and Ryan with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

Response to Arguments

14.   Applicant's arguments with respect to the pending claims filed on January 3, 2007 have been considered but are moot in view of the new ground(s) of rejection.

Examiner's Suggestions

15.   The examiner recommends amending the claims to describe in more detail the "deep domain knowledge" or the exact procedures or algorithms that are used in the claim data analyzing component. The applicants are reminded that any amendments to the claims must have support in the specification and furthermore that any amendments to the claims will be subjected to an updated prior art search.

Conclusion

16.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

US Patent Number 5,845,256 to Pescitelli teaches an interactive self-service

vending system.

"Building a self-service culture that works" teaches a self-service software system

for users.

17.   Any inquire concerning this communication or earlier communications from the

examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-

5109. The examiner can normally be reached from Monday to Friday between 8 AM and

4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's

supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone

numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official

communications including After Final communications labeled "Box AF").

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER

Another resource that is available to applicants is the Patent Application

Information Retrieval (PAIR). Information regarding the status of an application can be

obtained from the (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAX. Status information for unpublished

applications is available through Private PAIR only. For more information about the

PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the

Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at

866-217-9197 (toll-free).

Sincerely,

Vivek Koppikar

3/5/2007